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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,226	02/13/2002	Naoya Yamato	219107US0	4816
22850	7590	03/10/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			KIM, VICKIE Y	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			1614	
DATE MAILED: 03/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/073,226	YAMATO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vickie Kim	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 5-11, 21-23, 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 12-20, 24, 25 and 33-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgement is made of amendment filed 11/25/2003. Upon entering the amendment, the claims 1-2, 5-8 and 11 are amended and new claims 12-41 are added.
2. The claims 1-41 are pending. The elected claims 1-4(amended) and 12-20, 24-25, 33-41(new) whose subject matter are drawn to a compound are presented for the examination.

### ***Response to Arguments***

3. Applicant's arguments filed 11/25/03 have been fully considered but they are not persuasive. Applicant's response provides the arguments that proves the unexpected superior gelling effect(intended use) of the claimed compound and the improvement made in the cosmetic/pharmaceutical industry. However, applicant should be reminded that the examination is limited to the elected invention(compound) and thus, applicant's argument is not persuasive in this case. Until the elected invention is found to be allowable, applicant's argument should be limited to the compound.

The test for obviousness is not whether the features of a secondary teaching may be bodily incorporated into the structure of the primary teaching; nor is it that the claimed invention must be expressly suggested in the reference. Rather, the test is what the teachings of the reference would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Claim Rejections - 35 USC § 103***

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4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-4, 12-20, 24-25, 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al(US5591424).

The claims, now amended, are drawn to a compound having general formula recited in the instant claim 1 such as N-2-ethylhexanoyl (or octanoyl or decanoyl)-L-glutamic acid dibutylamide.

Hofrichter(US'424, hereafter) teaches N-acyl amino acid derivatives having the general formula which is generic to the claimed invention and embraces the scope of the instant claimed invention as well. For instance, N-lauroyl-glutamic acid dibutyl amide or N-stearoyl-glutamic acid dibutyl amide is exemplified as preferred species, see column 4, lines 35-67. The difference between the compound of the patent(i.e N-lauroyl(or stearoyl)-glutamic acid dibutyl amide) and the claimed compound in the instant application (i.e. N-octanoyl(or decanoyl)stearoyl-glutamic acid dibutyl amide) is based on the elongation of alkyl group. The skills and techniques for the said elongation process of alkyl groups are conventionally known in the art and commonly practiced in the industry and thus, the claimed species are clearly considered as obvious variants from the teaching of the patented disclosure, absent evidence to the contrary.

As to claims 16-20 and 37-41, the minor variations such as purification, chemical synthesis, isolation, crystal or hydrate form are considered to be conventional knowledge wherein the techniques and skills are well within the skilled level of the artisan and commonly practiced in the art(see PTO-892, evidentiary documents).

One would have been motivated to make such species because it is always desired to have extended family of the class because extended selection option increases industrial values and provides benefits to users due to easy accessibility and the competition which allow cost-effective manufacture. One would have been motivated to do so, with reasonable expectation of success, because the techniques and skills are suggested by the cited reference and also considered to be well within skilled level of the artisan. The teaching of the cited reference is particularly pertinent and relevant because the generic formula with the suggestion of the possible substitution to cover the claimed species is well taught in the cited reference. Thus, one would have been motivated to modify the teaching of this references because they are drawn to same technical fields (constituted with same ingredients and share common utilities, and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

### ***Conclusion***

6. No claim is allowed.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579(fax: 571-273-0579). The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 571-272-0584. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

**VICKIE KIM**  
**PRIMARY EXAMINER**

March 8, 2004  
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